

REMARKS

Claims 1-5, 16, 20, 24, and 35 have been cancelled without prejudice. Applicants reserve the right to pursue claims to the any cancelled subject matter in a divisional application. Claims 6-15 and 26-29 have been withdrawn by the Examiner. Claims 17, 21, 22, 25, 30-33, 36, 41, and 42 have been amended. Claim 44 is new. No new matter has been added. Upon entry of this amendment, claims 17-19, 21-23, 25, 30-34, and 36-44 are pending.

Claims 17, 21, 32 and 41 have been amended to correct dependencies as a result of cancellation of claims. Support for the amendment of claim 22 can be found at, for example, page 26, line 21 of the specification. Claim 25 has been amended for language clarification purposes only and the amendment is not made for reasons related to patentability. Furthermore, support for the amendment of claim 25 can be found at, for example, page 27, line 10 of the specification and the language of the amendment follows as a matter of logic from the disclosure. Claims 31 and 42 have been amended for language clarification purposes only and the amendments are not made for reasons related to patentability. Claim 36 has been amended to correct dependency and antecedent basis as a result of cancellation of claims. The amendment of claim 36 is not made for reasons related to patentability.

New claim 44 is in accordance with the Applicants election of species that was made in the paper filed on September 24, 2004 in response to the restriction requirement mailed August 25, 2004.

The Examiner's request for a priority claim paragraph at the beginning of page one is acknowledged and fulfilled.

The Examiner's finalization of the restriction requirement and withdrawal of claims 6-15 and 26-29 is acknowledged.

Improper Markush Rejection:

Claims 1-5, 16-25 and 30-43 were rejected for allegedly being "improper Markush claims". The Examiner has stated that this rejection would be overcome by limiting the claims to the elected species. Without acquiescence to the propriety of this rejection, the rejection is moot in light of cancellation of claims 1-5 and 16, and amendment of claims 17-25 and 30-43 to depend from new claim 44. Applicants submit that new claim 44 contains proper Markush language. Accordingly, withdrawal of the rejection is respectfully requested.

Obviousness-type Double Patenting:

Claims 1-4 and 30-43 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over U.S. Patent Nos. 6,316,479 and 6,649,635. The rejection is moot in light of cancellation of claims 1-5 and 16, and amendment of claims 17-

25 and 30-43 to depend from new claim 44. Applicants submit that the subject matter of new claim 44 does not overlap with the claims of U.S. Patent Nos. 6,316,479 and 6,649,635. Furthermore, since the present application and the currently pending claims were filed as a result of a restriction requirement, an obviousness-type double patenting rejection is not proper. Withdrawal of the rejection is respectfully requested.

Rejection Under 35 USC § 112, first paragraph:

Claims 1-4 and 30-43 were rejected under 35 USC § 112, first paragraph as allegedly not enabled for "any and all amides," see page 4, line 1 of the Office Action. And Claims 30-43 were further rejected under 35 USC § 112, first paragraph as allegedly not enabled for all cancers or for prevention. The rejection is obviated by of cancellation of claims 1-4 and amendment of claims 30-43. Furthermore, the rejection is traversed with respect to the currently pending claims.

First the Examiner alleges that "the specification, while being enabled for specific carboxamides, does not reasonably provide enablement for any and all amides," see page 3, paragraph 7 of the Office Action. Second the Examiner alleges that "the specification, while being enabled for specific diseases, does not reasonably provide enablement for the prevention of such diseases and for the treatment of all cancers," see page 4, paragraph 8 of the Office Action.

The rejection is moot as it pertains to claims 1-4 in light of cancellation of those claims. Furthermore, the Applicants submit that the disclosure is enabling for the scope of new claim 44, a point that the Examiner has already conceded by his admission that the specification is enabling for specific carboxamides, as noted above. The specification provides a lengthy detailed description of the compounds of the currently pending claims and numerous examples of the preparation of compounds of the present claims. Therefore, the Applicants submit that the disclosure is enabling for claim 44 and all claims dependent therefrom. Withdrawal of the rejection is respectfully requested.

Claims 30-36 were further rejected under 35 USC § 112, first paragraph as allegedly not enabled for all cancers or for prevention. The rejection as it pertains to prevention is obviated by amendment of claim 30. Claim 30 has been amended to remove the word "prevention." Accordingly, the Applicants submit that the disclosure is enabling for all claims dependent thereon. Furthermore, the rejection is moot as it pertains to "all cancers" in light of cancellation of claim 35. The applicants submit that the disclosure is enabling for the cancers listed in the currently pending claims, a point that the Examiner has already conceded by his admission that the specification is enabling for the treatment of specific diseases, as noted above. For example, the Background of the Invention provides a comprehensive summary of protein tyrosine kinases, their biology, and implication in a variety of human cancers, as well as providing a number of

supporting references. Further the specification provides results of biological assays demonstrating the desired utility of the compounds of the currently pending claims.

Therefore, the Applicants submit that the disclosure is enabling for claims 30-36. Withdrawal of the rejection is respectfully requested.

Rejection Under 35 USC § 102/35 USC § 103:

Claims 1-5, 16-22, 24 and 32 have been rejected under 35 USC § 102(a or b) as allegedly anticipated by or, in the alternative, under 35 USC § 103(a) as allegedly obvious over any of Eiken, et.al. (U.S. Patent No. 5,998,450); Sanfilippo, et.al. (U.S. Patent No. 5,342,851); Atwell, et.al. (J. Med. Chem., v. 37, no. 3, 371-380 (1994)); Huppatz, J.L. (U.S. Patent No. 4,214,090); Carter, et.al. (Annals of Applied Biology, v. 84, no. 3, 333-342 (1976)), and Wrzeciono, et.al. (Pharmazie, v. 31, no. 3, 149-50 (1976)). The rejection is moot as it pertains to claims 1-5 in light of cancellation of claims 1-5. The rejection is traversed with respect to all currently pending claims.

The Examiner has rejected the present claims under 35 USC § 102(a or b) as allegedly anticipated by references found in an STN structure search print-out (a copy of which the examiner has provided for the Applicants reference) and stating that the "references disclose specific N-(4-substituted-phenyl)pyrazolylcarboxamides with in the present claims" (page 5, point 12 of the Office Action).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The rejection under 35 USC § 102(a or b) is moot in light of cancellation of claims 1-5 and 16, and amendment of claims 17-22, 24 and 32 to depend from new claim 44. Furthermore, the Applicants submit that none of the STN citations teach any compound that falls within the genus of new claim 44. Therefore, none of the currently pending claims (17-19, 21-23, 25, 30-34, and 36-44) are anticipated by any of the references. Withdrawal of the rejection under 35 USC § 102(a or b) is respectfully requested.

Alternatively, the Examiner has rejected the present claims under 35 USC § 103(a) as allegedly obvious over the references found in an STN structure search print-out. In particular, the Examiner alleges that "the compounds within the present claims are generically disclosed and/or are simple homologs and analogs of the specific compounds of the references" (page 5, point 12 of the Office Action). The rejection of claims 1-5, 16-22, 24 and 32 is moot in light of cancellation of claims 1-5. The Applicants respectfully traverse the rejection with respect to the currently pending claims.

Section 2143 of the MPEP states that to establish a case of *prima facie* obviousness, the Examiner must satisfy three basic criteria:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference must teach all of the claim limitations.

Here, the Examiner has clearly failed to establish these three criteria. Specifically, the Examiner has provided no clear suggestion or motivation as defined by the legal standard. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so, found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d, 1430, 1433-34 (Fed. Cir. 2002). Nor has the Examiner provided any basis for one of ordinary skill in the art to believe that there is a reasonable expectation of success by making the combination that he has proposed. Finally, none of the cited references or any of the remaining STN search hits teaches any compound that falls within the scope of the currently pending claims, and since none of the references provides any suggestion or motivation to combine their teachings, then no such combination in support of obviousness would be proper.

With regard to the Examiner's assertion in support of obviousness that the compounds of the present claims are simple homologs and analogs of the specific compounds of the references, the Applicants respectfully disagree with the Examiner on both of these points.

First, section 2144.09 of the MPEP defines homologs as compounds differing regularly by the successive addition of the same chemical group, e.g., by $-CH_2-$ groups. Here the Applicants submit that, even when considered under a broad interpretation of the MPEP definition of homolog, the compounds of the currently pending claims are sufficiently different from the compounds described by the references that they cannot be regarded as homologs under the MPEP definition.

Second, in regard to the Examiner's assertion that the compounds of the present claims are analogs of the specific compounds of the references, where there is close analogy between compounds, there must be adequate support in the prior art for the change in structure, in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant. In *re Grabiak*, 769 F.2d 729; 226 U.S.P.Q. (BNA) 870 (Fed. Cir. 1985). The Applicants submit that even if the compounds of the present claims were to have structural similarity (i.e. analogy) with the compounds of the references cited in the STN search results, that none of the references cited provides any support for the changes in structure that would be necessary to arrive at the compounds of the currently pending claims.

The Examiner is citing non-analogous art in support of an argument for *prima facie* case of obviousness. Specifically, the present application is directed to compounds that are expected

to exhibit a salutary effect on disorders related to abnormal protein tyrosine kinase activity. The Applicants submit that none of the references are directed to even a similar utility or problem being solved by the compounds described therein as the present application. Specifically, Eicken, et.al., Huppatz, J.L., and both citations of Carter, et.al., relate to fungicides; both citations of Reidalova, et.al., are directed to plant growth-regulating activity, both citations of Kim, et.al., are directed to the chromatographic separation of pesticides; Sanfilippo, et.al., is directed to platelet aggregation inhibitors; Atwell, et.al., is directed to aromatic mustard derivatives; Borisevich, et.al., is directed to the reaction of arylamides with hydroxylamine and substituted hydrazines; and Wrzeciono, et.al., is directed to sulfonamides. The Applicants submit that one of ordinary skill in the art of the discovery of compounds for use as protein tyrosine kinase inhibitors would find no motivation to use or modify the compounds disclosed in any of the cited references because none of the references provide teachings analogous to disorders related to abnormal protein tyrosine kinase.

Finally, with regard to the Examiner's assertion at page 5, point 12 that "[w]here not anticipated, the compounds within the present claims are generically disclosed", the Applicants submit that none of the compounds described in the references, either specifically or generically, fall within the scope of the currently pending claims. If true, that would mean that the reference would be prior art under 35 USC § 102 and not 35 USC § 103(a). Since none of the STN citations teach any compound that falls within the genus of new claim 44, a rejection under 35 USC § 102 is not proper.

Accordingly, in view of the above, the Applicants submit that no reasonable argument for *prima facie* obviousness can be put forth. Withdrawal of the rejection under 35 USC § 103(a) is respectfully requested.

Conclusion

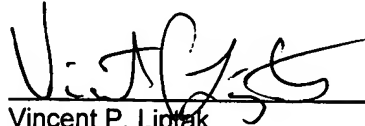
The Applicants respectfully request reconsideration based on the present amendments and remarks.

The Applicants submit that the application is in condition for allowance. Early notice of allowance is respectfully requested.

If any fees other than those submitted herewith are due in connection with this response, including the fee for any required extension of time (for which Applicants hereby petition), please charge such fees to Deposit Account No. 500329.

Respectfully submitted,

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Vincent P. Liptak
Agent For Applicants
Registration No. 53,225

Agouron Pharmaceuticals, Inc./A Pfizer Company
Patent Department
10777 Science Center Drive
San Diego, California 92121
Phone: (858) 622-3087
Fax: (858) 678-8233